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REMARKS/ARGUMENTS

1. Summary of the Office Action

Claim 21 is provisionally objected to based on a double patenting rejection.

Claim 11 is rejected under § 112 as allegedly being indefinite.

Claims 8-9, 13, 15-18, 20-23 and 25-27 stand rejected under § 102(b) as allegedly being anticipated by U.S. patent no. 5,781,714 (hereinafter "Collins et al.").

Claims 1-7 and 28-30 stand rejected under § 103(a) as allegedly being unpatentable over U.S. patent no. 6,065,084 (hereinafter "Simon et al.") in view of U.S. patent no. 5,781,714 (hereinafter "Collins et al.").

Claims 10-12, 14, 19, and 24 stand rejected under § 103(a) as allegedly being unpatentable over U.S. patent no. 5,781,714 (hereinafter "Collins et al.") in view of U.S. patent no. 6,065,0084 (hereinafter "Simon et al.").

2. Response to Double Patenting Provisional Rejection

Claim 21 has been cancelled to eliminate any ground for potential double patenting rejection.

3. Response to § 112 Rejection

It should be noted that the operative standard for determining whether the definiteness requirement of the relevant statute has been met is "whether those skilled in the art would understand what is claimed when the claim is read in the light of the specification." The Beachcombers Intn'l, inc. v. Wilde Wood creative products, Inc., 31 USPQ 2d 1653, 1656

(Fed. Cir. 1994) (citing Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d, 1565, 1 USPQ 2d 1081, 1088 (Fed. Cir. 1986)).

Claim 11 has been amended to replace the phrase “what glyph sub-sets, if any, may already exist” with the phrase “if the glyph sub-set already exists”. Thus, the indefiniteness rejection has been overcome.

4. Response to § 102 Rejections

Applicants respectfully traverse this rejection for the reasons set out below, and ask the Examiner for reconsideration.

To anticipate a claim, the reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

i. COLLINS DOES NOT TEACH EVERY ELEMENT OF CLAIM 8

Claim 8 reads as follows:

A method for dynamic font subsetting, the method including:

on an intermediate network device, identifying a glyph set in a requested electronic content;

identifying a glyph sub-set from the glyph set, the glyph sub-set including only glyphs identified in the requested electronic content;

inserting one or more directives into the requested electronic content to create modified electronic content, the one or more directives identifying the glyph set and an encoding scheme used to encode the glyph set;

receiving a request on the intermediate network device from an electronic device for the glyph sub-set, the request being generated by the electronic device as a result of the one or more directives;

obtaining the glyph sub-set; and

sending the glyph sub-set to the electronic device to allow the electronic device to display glyphs in the modified electronic content.

Collins, on the other hand, discloses an HTML document author creating HTML text, after which the PFR tags are inserted in HTML files by a program MakePfrsForFiles.exe. Collins, 30: 50-65.

In Collins, the PFR tags are not inserted into **the requested electronic content** as required by claim 1. Rather, in Collins, the tags are inserted when an HTML file is created and being prepared for distribution (Collins, 30: 50-65), or when a large number of changes have been made to the web site (Collins, 31, 31-37). This is in stark contrast to “**inserting one or more directives into the requested electronic content to create modified electronic content**, the one or more directives identifying the glyph set and an encoding scheme used to encode the glyph set”, as required by claim 8.

Because not every element of claim 8 is disclosed in Collins, claim 8 and its dependent claims 9-14 are patentable over Collins and should be allowed.

ii. COLLINS DOES NOT TEACH EVERY ELEMENT OF CLAIM 15

Claim 15 reads as follows:

A method for dynamic font subsetting, comprising:

sending a first request from an electronic device to an intermediate network device for electronic content on a computer network;

responsive to the sending of the first request for the electronic content, receiving modified electronic content from the intermediate network device on the electronic device, wherein the modified electronic content is created responsive to the first request and includes one or more directives, wherein a directive identifies a glyph sub-set including a set of

glyphs identified in the modified electronic content and an encoding scheme used to encode the set of glyphs;

processing the modified electronic content, thereby identifying the one or more directives;
sending a plurality of second requests to the intermediate network device based on the one or more identified directives to request one or more glyph sub-sets to allow the electronic device to display the modified electronic content; and
receiving one or more glyph sub-sets from the intermediate network device; and
displaying the modified electronic content using the one or more glyph sub-sets.

In Collins, the PFR tags are not inserted **responsive to a request for electronic content**, as required by claim 1. Rather, in Collins, the tags are inserted when an HTML file is created and being prepared for distribution (Collins, 30: 50-65), or when a large number of changes have been made to the web site (Collins, 31, 31-37). This is in stark contrast to “responsive to the sending of the first request for the electronic content, receiving modified electronic content from the intermediate network device on the electronic device, **wherein the modified electronic content is created responsive to the first request** and includes one or more directives, wherein a directive identifies a glyph sub-set including a set of glyphs identified in the modified electronic content and an encoding scheme used to encode the set of glyphs”, as required by claim 15.

Because not every element of claim 15 is disclosed in Collins, claim 15 and its dependent claims 16-21 are patentable over Collins and should be allowed.

iii. COLLINS DOES NOT TEACH EVERY ELEMENT OF CLAIM 22

Claim 22 reads as follows:

A method for dynamic font sub setting, including:

reading modified electronic content from local storage on an electronic device, wherein the modified electronic content includes one or more directives, wherein a directive from the one or more directives identifies a glyph sub-set including a set of glyphs identified in requested electronic content and an encoding scheme used to encode the set of glyphs;

processing the modified electronic content on the electronic device, thereby identifying the one or more directives, **the directives being inserted in the requested electronic content** to create the modified electronic content;

determining from the one or more directives whether a desired glyph sub-set can be obtained from local storage on the electronic device, and if not, sending requests to an intermediate network device to obtain glyph sub-sets that can not be obtained from local storage on the electronic device;

receiving the glyph sub-sets that can not be obtained from local storage from the intermediate network device on the electronic device; and

displaying the modified electronic content on the electronic device using the glyph sub-sets obtained from the intermediate network device.

Collins discloses a method, in which a browser on the client computer determines whether or not the portable font is in cache on the client computer. If it is, then the HTML document is displayed based on the portable font obtained from local cache. Otherwise, a request is made to the server to obtain that portable font. (Collins, 31: 3-20). A file containing an appropriate portable font is identified by portable font tags in the HTML text. (Collins, 29: 41-55). There is no indication in Collins, however, that the portable font tags are inserted into the **requested electronic content**. This is in stark contrast to “the one or more directives, **the directives being inserted in the requested electronic content** to create the modified electronic content”, as required by claim 22.

Because not every element of claim 22 is disclosed in Collins, claim 22 and its dependent claims 23-27 are patentable over Collins and should be allowed.

5. Response to § 103 Rejections

Applicants respectfully traverse this rejection for the reasons set out below, and ask the Examiner for reconsideration.

*To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).*

**THE PRIOR ART REFERENCES DO NOT TEACH OR SUGGEST ALL CLAIM
LIMITATIONS, WHEN CONSIDERED SINGULARLY OR IN COMBINATION.**

Claim1

Claim 1 reads as follows:

A method for dynamic font subsetting, including:

receiving a first request on an intermediate network device from an electronic device for electronic content, the electronic content including a plurality of characters in one or more desired languages;

obtaining the requested electronic content on the intermediate network device from a computer network;

on the intermediate network device, scanning the requested electronic content to identify one or more sets of glyphs in the electronic content used for the plurality of characters in the one or more desired languages;

creating one or more glyph sub-sets for the one or more identified sets of glyphs, wherein the one or more glyph sub-sets include only glyphs identified in the requested electronic content;

on the intermediate network device, responsive to the scanning of the requested electronic content and the creating of the one or more glyph subsets, inserting one or more directives in the requested electronic content to identify the one or more glyph sub-sets needed

to display the plurality of characters in the one or more desired languages in the requested electronic content, thereby creating modified electronic content, wherein a directive from the one or more directives identifies a glyph sub-set including a set of glyphs from the one or more sets of glyphs identified in the requested electronic content and an encoding scheme used to encode the set of glyphs; and

 sending the modified electronic content to the electronic device.

Simon, on the other hand, discloses a scenario where a user downloads a Web page from the Internet. In particular, Simon discloses the following:

As the size of the font file grows, it is less convenient to supply the entire font for each application or usage of the font. For example, when **a user downloads a Web page from the Internet**, there is often no need for an entire font to accompany the Web page for rendering the small amount of textual content expressed on the page. Rather than downloading the entire font file (which might be large), a subset of the font file is downloaded. The subsetted font contains enough rules and glyph information to present the characters contained in the Web page.

Simon, 1:36-46.

Collins discloses the following:

A computer system includes a requesting computer which asks a responding computer, such as an Internet server, for one or more portions of text. The responding computer reacts by sending the requested text. The requesting computer can either render the requested text without the text's font shapes, or it can ask the responding computer to send descriptions of such shapes, and then render the text using them.

Collins, Abstract.

Neither Simon, nor Collins, or a combination thereof discloses “**receiving a first request on an intermediate network device** from an electronic device for electronic content”, as required by claim 1. The Office Action suggests that a method in which a web page is downloaded from the Internet entails a request from a computer to a network device. However, there is no indication in Simon or Collins that the network device is an intermediate network device. On the contrary,

Simon discloses an example of font distributor being a web page owner who might wish to subset the font file for convenience of the client. Simon, 4: 7-9. In other words, in Simon, a user downloads a Web page from the source of the electronic content (e.g., a content distributing web server) via the Internet without using an intermediate network device. Similarly, in Collins, there is no suggestion that an intermediate network device is used. In Collins, a requesting computer asks a responding computer, such as an Internet server, for one or more portions of text, after which the responding computer reacts by sending the requested text. Collins, Abstract. This is distinct from **“receiving a first request on an intermediate network device from an electronic device for electronic content”**, as required by claim 1.

The Office Action failed to address the limitation of claim 1 requiring **“obtaining the requested electronic content on the intermediate network device from a computer network”**. Neither Simon, nor Collins, or a combination thereof discloses this feature of claim 1.

Neither Simon, nor Collins, or a combination thereof disclose **“on the intermediate network device, responsive to the scanning of the electronic content and the creating of the one or more glyph subsets, inserting one or more directives in the requested electronic content”**, as required by claim 1. The Office Action agrees that this feature is not disclosed in Simon. (Detailed Action, p. 11.) In Collins, the HTML text uses PFR tags to identify URLs pointing to PFR files containing the necessary font descriptions. Collins, 29: 41-55. The PFR tags are inserted in HTML files by a program Make PfrsForFiles.exe, which resides on a server, which distributes the electronic content, and not on an intermediate network device, as required by claim 1. Collins, 30: 50-65; Fig. 22.

Furthermore, in Collins, the tags are not inserted into **“the requested electronic content”**, or **“responsive to the scanning of the electronic content and the creating of the one or more glyph subsets”**, as required by claim 1. Rather, in Collins, the tags are inserted when an HTML file is created and being prepared for distribution (Collins, 30: 50-65), or when a large number of changes have been made to the web site (Collins, 31, 31-37), without taking into consideration whether the electronic content was ever requested. This is in stark contrast to **“on the intermediate network device, responsive to the scanning of the electronic content and the**

creating of the one or more glyph subsets, inserting one or more directives in the requested electronic content”, as required by claim 1.

Neither Simon, nor Collins, or a combination thereof disclose creating modified electronic content by inserting directives into the **requested** electronic content, as required by claim 1. The Office Action agrees that this feature is not disclosed in Simon. (Detailed Action, p. 11.) In Collins, the modified electronic content is created prior to a request by the user. Collins, 30: 50-65; 31, 31-37. This is distinct from “inserting one or more directives in the requested electronic content ... thereby creating modified electronic content”, as required by claim 1.

Because Simon does not disclose every element of claim 1, whether considered separately or in combination with Collins, claim 1 and its dependent claims 2-7 are patentable and should be allowed.

Claim 28

Claim 28, as amended, reads as follows:

A dynamic font subsetting system, including:

a plurality of directives for identifying a glyph sub-set including a set of glyphs identified in electronic content and an encoding scheme used to encode the set of glyphs, wherein the set of glyphs are used to display a plurality of characters in one or more desired languages for the electronic content;

modified electronic content created responsive to a request for the electronic content and including one or more directives for identifying one or more glyph sub-sets, the one or more glyph sub-sets including sets of glyphs identified in the electronic content and encoding schemes used to encode the sets of glyphs; and

an electronic device for displaying the modified electronic content, wherein the electronic device has resources insufficient to store all glyphs for all characters in a desired language.

Neither Simon, nor Collins, or a combination thereof disclose “**modified electronic content created responsive to a request for the electronic content** and including one or more directives for identifying one or more glyph sub-sets, the one or more glyph sub-sets including sets of glyphs identified in the electronic content and encoding schemes used to encode the sets of glyphs”, as required by claim 28. The Office Action agrees that Simon does not disclose a method in which directives are inserted into the electronic content to identify the glyph subsets necessary. (Detailed Action, p. 11.) In Collins, the modified electronic content is created prior to a request by the user. Collins, 30: 50-65; 31, 31-37. This is distinct from “**modified electronic content created responsive to a request for the electronic content**”, as required by claim 28.

Because Simon does not disclose every element of claim 28, whether considered separately or in combination with Collins, claim 28 and its dependent claims 29-30 are patentable and should be allowed.

Claims 10-12 and claim 14

Claims 10-12 and claim 14 include the feature of “**inserting one or more directives into the requested electronic content to create modified electronic content**, the one or more directives identifying the glyph set and an encoding scheme used to encode the glyph set” by virtue of being dependent on claim 8. Thus, claims 10-12 and claim 14 are allowable for at least the reasons articulated with respect to claim 28.

Claim 19

Claim 19 includes the feature of “responsive to the sending of the first request for the electronic content, receiving modified electronic content from the intermediate network device on the electronic device, wherein **the modified electronic content is created responsive to the first request and includes one or more directives**, wherein a directive identifies a glyph sub-set

including a set of glyphs identified in the modified electronic content and an encoding scheme used to encode the set of glyphs" by virtue of being dependent on claim 15. Thus, claim 19 is allowable for at least the reasons articulated with respect to claim 28.

Claim 24

Claim 24 includes the feature of "**the directives being inserted in the requested electronic content to create the modified electronic content**" by virtue of being dependent on claim 22. Thus, claim 24 is allowable for at least the reasons articulated with respect to claim 28.

In light of the above, Applicants respectfully submits that the rejection under 35 U.S.C. § 103 has been overcome, and withdrawal of this rejection is therefore respectfully requested.

6. Conclusion

In light of the above, Applicants respectfully submit that all rejections have been addressed and that the claims are now in a condition for allowance, which is earnestly solicited.

If there are any additional charges, please charge Deposit Account No. 02-2666. If a telephone interview would in any way expedite the prosecution of the present application, the Examiner is invited to contact Elena Dreszer at (408) 947-8200 ext. 209.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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Elena B. Dreszer
Reg. No. 55,128

12400 Wilshire Blvd.
Seventh Floor
Los Angeles, CA 90025-1026
(408) 947-8200